

## ***Remarks***

### **A. THE PATENT OFFICE HAS SHOWN NO MOTIVATION TO COMBINE ALL THE REFERENCES**

Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. sec. 103(a).

**“Virtually all [inventions] are combinations of old elements.”** Environmental Designs, Ltd. v. Union Oil Co., 713 F. 2d 693, 698 (Fed.Cir. 1983). In In Re Rouffet, 149 F.3d 1350, 47 U.S.P.Q. 2d 1453 (1998), it states that an examiner of a claimed invention can often find every element in the prior art, and if identification of each claimed element in the prior art was sufficient to negate patentability, very few patents would ever issue. So, rejecting patent applications solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. **That approach would be “an illogical and inappropriate process by which to determine patentability.”** Sensonics, Inc. v. Aerosonic Corp., 81 F. 3d 1566, 1570, 38 U.S.P.Q. 2d 1551, 1554 (Fed. Cir. 1996).

To prevent using hindsight, based on the invention itself, to defeat patentability of the invention, the examiner must show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior references for combination in the manner claimed. In Re Rouffet, 149 F.3d 1350, 47 U.S.P.Q. 2d 1453

(1998); MPEP 2142. An examiner cannot use hindsight in selection of references that comprise the case of obviousness.

When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. See In re Geiger, 815 F. 2<sup>nd</sup> 686, 688 (Fed. Cir. 1987); see, also, In Re Rouffet, 149 F.3d 1350, U.S.P.Q. 2d 1453 (1998).

*In this matter, the Patent Office has shown absolutely no motivation or suggestion or teaching to combine 4 documents to show obviousness.* In fact, the Applicant has shown just the opposite! There is no motivation or suggestion to combine these 4 items. (See, Third Affidavit of Allan Todd Berry).

The courts forbid the use of hindsight in selection of references that comprise the case of obviousness. In this matter, that is what is being done.

The Patent Office has looked at Applicant's patent application and has pieced together elements of other patents (or applications) and concluded that Applicant's invention is obvious. There has been absolutely no showing of a motivation to combine all these different documents to piece together Applicant's invention. So, if there is no motivation to combine all the documents, then Applicant's invention cannot be obvious.

**B. THE PATENT OFFICE NEVER EVEN CONSIDERED APPLICANT'S EVIDENCE OF SECONDARY CONSIDERATIONS IN CONSIDERING OBVIOUSNESS VS. NON-OBVIOUSNESS WHICH IS CLEAR ERROR**

In considering the evidence on the obviousness vs. non-obviousness issue, the Court, even in Graham said and as other courts have emphasized, *it must include evidence on secondary considerations and it is error to exclude that evidence from consideration.* Stratoflex, Inc. v. Aeroquip Corp., 713 F. 2d 1530 (1983). The Federal

Circuit has instructed that the secondary considerations and objective factors must be considered in every case, both by the courts and PTO. Custom Accessories, Inc. v. Jeffrey-Allan Industries, Inc., 807 F. 2d 955 (Fed. Cir.1986).

The Patent Office did not even consider any of the secondary considerations in making its obvious vs. un-obvious determination. It said that those considerations were “moot.” That is clear error. That is just not following the patent law.

In Re Rouffet, 149 F.3d 1350, 47 U.S.P.Q. 2d 1453 (1998), it is clear that secondary considerations are essential components of the obviousness determination. This **objective test of non-obviousness** includes, but is not limited, to: (1) commercial success; (2) satisfying a long felt but unresolved need; (3) failure of others; (4) unexpected properties of the claimed invention and (5) copying or adoption by others.

In this matter, the Patent Office did not consider any of the factors and evidence proffered by Applicant. Those include:

- 1) Commercial success – In Allan Todd Berry’s Second Affidavit he identifies the commercial success of the invention with its combination of elements. He states, in part, “Those customers are identified in Exhibits 1 and 2. The invoices total more than \$1.8 million dollars. With over \$1.8 million in sales of my invention, my invention, as the features recited in the claims, is a commercial success.” (emphasis supplied).
- 2) Satisfies a long felt need – In Allan Todd Berry’s initial Affidavit he states, in part, “In January of 2002, China began to put restrictions on the quality of the chicken paws they were receiving from the United States. Since then, many poultry processors ceased producing the paws because there was not a viable method for determining the quality of the feet. The invention of the current patent application, in conjunction with the USDA inspectors input, can accurately determine which paws are acceptable and which are not. Therefore, my invention satisfies the need long felt by the poultry industry. It is the only system readily available that meets the criteria of the existing FSIS Directive 6210.2 as it is written.”

- 3) Failure of others - item 2 above, shows that others have failed to meet the requirements of the directive, while Applicant's invention has met such requirements.

These factors show that Applicant's invention is not obvious.

### **C. THE "PRIOR ART" CITED**

As previously stated, Applicant does not believe that all the documents cited by the PTO are prior art and can be combined. In fact, Applicant has shown otherwise. The PTO has not shown any suggestion that these documents can be put together at the time of Applicant's invention to form his invention.

With that said, the latest "prior art" document, U.S. Patent No. 4,372,099 to Linville, is for a "method of packing poultry." Applicant's invention is for a process to electronically automate the sorting of chicken feet into the category of edible or inedible. Applicant's invention has nothing to do with determining the weight of poultry in a box like Linville. It should not be used as a prior art document. See, In re Clay, 966 F. 2d 656 (Fed Cir. 1992). But for argument purposes, it makes reference to only one flag on a shackle. Applicant has redrafted his claims to circumvent this objection.

With respect to U. S Patent No. 4,150,374 to Brook, at a minimum, it does not depict any flags, an inspection station, an inspection button, a programmable communication card and a means to interface to an inspection station to a programmable means. It does depict, admittedly, sensing devices to count whole birds.

With respect to U.S. Patent Application 2003/0139130A1 to Steffler, at a minimum, it does not depict any flags and the inspection button interfacing with a programmable means.

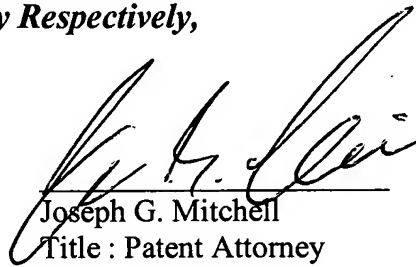
With respect to U.S. Patent Application 2003/0065414 to van den Nieuwelaar et al., it is only cited by the PTO to depict an inspection station that interfaces with a programmable means. It has nothing to do with a process to electronically automate the sorting of chicken feet into the category of edible or inedible like Applicant's invention. Van den Nieuwelaar should also not be used as a prior art document. See, In re Clay, 966 F. 2d 656 (Fed Cir. 1992).

The claims have been re-drafted to remove all objections by the PTO at this point. They have been narrowed such that the patent is ready to issue.

### **Conclusion**

For all the foregoing reasons, Applicant submits that the specification, drawings, and claims are now in proper form, and that the claims all define patentably over the prior art. Therefore, Applicant submits that his patent application is now in condition for allowance, which action he respectfully requests.

*Very Respectively,*



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Dated : 1-4-2006